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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,782	10/16/2003	Tomohito Ota	023971-0323	7012
22428	7590	01/28/2008		
FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			EXAMINER GOLOBOY, JAMES C	
			ART UNIT	PAPER NUMBER
			1797	
			MAIL DATE	DELIVERY MODE
			01/28/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/685,782

**Applicant(s)**

OTA ET AL.

**Examiner**

James Goloboy

**Art Unit**

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5,6 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5,6,12 and 14 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9/21/07.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The rejection of claims 5 forth in the office action mailed 6/6/07 have been maintained below. Applicant's arguments regarding the rejection of claim 6 are persuasive; however, claim 6 has been rejected over a reference cited in a newly submitted IDS. Newly added claims 12 and 14 have also been rejected for the reasons discussed below.

#### ***Claim Rejections - 35 USC § 112***

2. Claims 13-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 13-14 recite resinous material compositions containing 20 parts by weight of a fluororesin and 80 parts by weight of specific thermoplastic resins. As the concentrations of the components add up to 100 parts by weight, the composition should be closed to additional components, but the claims use the open-ended "comprising", implying that the resinous material can include additional components. It is also noted that the application as originally filed does not provide support for resinous materials of this type that contain components other than the fluororesin and the thermoplastic resin. The examiner therefore recommends that "comprising" be changed to "consisting of".

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 6 and 14 rejected under 35 U.S.C. 102(a) as being anticipated by JP 2002-265630.

An English machine translation of the JP '630 reference has been relied upon in setting forth this rejection. In paragraph 19, JP '630 discloses a resin composition comprising polyetheretherketone (PEEK), a thermoplastic resin, and polytetrafluoroethylene (PTFE), a fluororesin. The resin is made by heating and kneading together the PEEK and PTFE, as recited in claim 6. In examples 3-6 Table 1 of JP 630, the weight proportions of PEEK and PTFE fall within the ranges recited in claim 6 (based on a total concentration of 100 parts per weight for the composition). The resin of JP '630 therefore meets the limitations of claim 6. In paragraph 9, JP '630 teaches that the thermoplastic resin can be polyamidoimide (PAI). When PAI is substituted for PEEK in examples 4-5 of JP '630, the limitations of claim 14 are met.

#### ***Claim Rejections - 35 USC § 103***

5. Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seguchi in view of JP 63-179965 and Wicks.

The rejection of claim 5 is adequately set forth in paragraph 3 of the office action mailed 6/6/07, which is incorporated here by reference. Since Seguchi and JP '965

disclose a composition comprising the resinous material of claim 12 and a lubricating oil, the lubricating oil will clearly be in contact with the resinous material, as in claim 12, and as JP '965 further teaches that the lubricating oil lubricates the resinous material (see page 5 of the translation of JP '965 entered into the record on 1/19/07), the limitations of claim 12 are met as well.

### ***Allowable Subject Matter***

6. Claim 13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. The prior art, as exemplified by JP '630 discloses a resinous material made from a fluororesin and a thermoplastic resin, but does not teach or suggest the use of polyamide 66 resin as the thermoplastic resin.

### ***Response to Arguments***

7. Applicant's arguments filed have been fully considered but they are not persuasive.

Applicant argues that the lubricating oil of JP '965 is incorporated into the composition rather than in contact with the resin. However, these are not mutually exclusive, and a lubricating oil incorporated into a resinous material is clearly in contact with the material. It is further noted that JP '965 discloses that the lubricant reduces the friction coefficient and improves the abrasion resistance and sliding property of the

resinous material, illustrating that the lubricating oil is lubricating the surface of the material.

Applicant further argues that the data reported pages 17-24 of the specification provide objective evidence of nonobviousness. However, the examples for which the data is reported are specific resins with specific concentrations of specific thermoplastic resins and fluororesins, and therefore not commensurate with the scope of claim 5, which recites and fluororesin and any thermoplastic resin in a broader concentration range.

Applicant's arguments regarding claim 6 are moot in light of the new ground of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is 571-272-2476. The examiner can normally be reached on M-F 9-5:30.

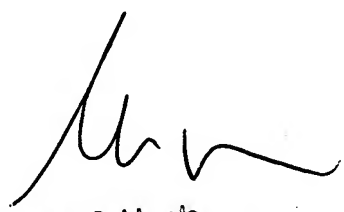
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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